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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,715	10/18/2004	Alfred Ruland	259939US0PCT	9295

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
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1751

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/28/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/28/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/510,715

Applicant(s)

RULAND ET AL.

Examiner

Brian P. Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/4/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-17 and 20-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dahlgren et al, WO 94/11331.

Dahlgren et al, WO 94/11331, discloses an alkoxylate of 2-propyl-heptanol of formula (I) and formula (II) that contains blocks of ethylene oxide and propylene oxide (see abstract and page 1, line 34-page 2, line 21). It is further taught by Dahlgren et al that the alkoxylates are made by reacting the alkylene oxide with 2-propyl-heptanol in the presence of a catalyst (see page 2, line 22-page 3, line 15), and that the compositions are used for washing hard surfaces (see page 3, lines 1-15), per the requirements of the instant invention. Specifically, note Examples 1-2 and Tables 1-4. Therefore, claims 11-17 and 20-30 are anticipated by Dahlgren et al, WO 94/11331.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce

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the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

5. Claims 11-17 and 20-30 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gumbel et al, U.S. Patent No. 6,680,412.

Gumbel et al, U.S. Patent No. 6,680,412, discloses mixtures of alcohol alkoxylates of formula (I) and formula (II) for use as foam-inhibiting surfactants (see abstract and col. 1, line 45-col. 2, line 19). It is further taught by Gumbel et al that that the radical R^1 is a C_{8-12} alkyl radical that contains one single branch and/or two or more branches (see col. 2, lines 49-529), and that the alkoxylates are made by reacting the alcohols with the alkylene oxides in the presence of catalysts (see col. 3, lines 16-32), per the requirements of the instant invention. Gumbel et al further discloses that the alkoxylates are used for treating metals, fibers, paper, and for the preparation of polymer dispersions (see col. 3, line 50-col. 4, line 51). Specifically, note Examples 1-25. Therefore, claims 11-17 and 20-30 are anticipated by Gumbel et al, U.S. Patent No. 6,680,412.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

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6. Claims 11-17 and 20-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoffarth, U.S. Patent No. 5,705,476.

Hoffarth, U.S. Patent No. 5,705,476, discloses low-foaming wetting agents comprising an ethoxylated-propoxylated alcohol of formula (Ic), wherein R¹ is isodecyl (see abstract, col. 1, lines 45-col. 2, lines 46, and col. 2, line 66-col. 3, line 11). It is further taught by Hoffarth that the low-foaming wetting agents are used for treating crops, textiles and other surfaces (see abstract and col. 4, lines 10-24), per the requirements of the instant invention. Specifically, note Examples A-K. Therefore, claims 11-17 and 20-30 are anticipated by Hoffarth, U.S. Patent No. 5,705,476.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

7. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlgren et al, WO 94/11331, in view of Clement et al, WO 01/04183.

The primary reference of Dahlgren et al, WO 94/11331, is relied upon supra as disclosing an alkoxylate of 2-propyl-heptanol of formula (I) and formula (II) that contains blocks of ethylene oxide and propylene oxide (see abstract and page 1, line 34-page 2, line 21). It is further taught by Dahlgren et al that the alkoxylates are made by reacting the alkylene oxide with 2-propyl-heptanol in the presence of a catalyst (see page 2, line

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22-page 3, line 15), and that the compositions are used for washing hard surfaces (see page 3, lines 1-15), per the requirements of the instant invention. Dahlgren et al does not teach or suggest in general making their alkoxylates in the presence of a double-metal cyanide catalyst, as required in instant claims 18-19.

The secondary reference of Clement et al, WO 01/04183, discloses a process for preparing ethyleneoxide-propyleneoxide alcohols with metal cyanide catalysts (see abstract). It is further taught by Clement et al that double-metal cyanide catalysts enhance and make easier the polymerization of polymers that contain both blocks of propyleneoxide and ethyleneoxide (see page 2, lines 2-23).

Therefore, in view of the teachings of the secondary reference of Clement et al, one having ordinary skill in the art would be motivated to modify the primary reference of Dahlgren et al by using a double-metal cyanide catalyst to enhance the polymerization process. Such modification would be obvious because one would expect that the use of a double-metal cyanide catalyst, as taught by Clement et al, would be similarly useful and applicable to the analogous polymerization process taught by Dahlgren et al.

8. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gumbel et al, U.S. Patent No. 6,680,412, in view of Clement et al, WO 01/04183.

The primary reference of Gumbel et al, U.S. Patent No. 6,680,412, is relied upon supra as disclosing mixtures of alcohol alkoxylates of formula (I) and formula (II) for use as foam-inhibiting surfactants (see abstract and col. 1, line 45-col. 2, line 19). It is

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further taught by Gumbel et al that that the radical R^1 is a C_{8-12} alkyl radical that contains one single branch and/or two or more branches (see col. 2, lines 49-529), and that the alkoxylates are made by reacting the alcohols with the alkylene oxides in the presence of catalysts (see col. 3, lines 16-32), per the requirements of the instant invention. Gumbel et al further discloses that the alkoxylates are used for treating metals, fibers, paper, and for the preparation of polymer dispersions (see col. 3, line 50-col. 4, line 51). Gumbel et al does not teach or suggest in general making their alkoxylates in the presence of a double-metal cyanide catalyst, as required in instant claims 18-19.

The secondary reference of Clement et al, WO 01/04183, discloses a process for preparing ethyleneoxide-propyleneoxide alcohols with metal cyanide catalysts (see abstract). It is further taught by Clement et al that double-metal cyanide catalysts enhance and make easier the polymerization of polymers that contain both blocks of propyleneoxide and ethyleneoxide (see page 2, lines 2-23).

Therefore, in view of the teachings of the secondary reference of Clement et al, one having ordinary skill in the art would be motivated to modify the primary reference of Gumbel et al by using a double-metal cyanide catalyst to enhance the polymerization process. Such modification would be obvious because one would expect that the use of a double-metal cyanide catalyst, as taught by Clement et al, would be similarly useful and applicable to the analogous polymerization process taught by Gumbel et al.

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9. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffarth, U.S. Patent No. 5,705,476, in view of Clement et al, WO 01/04183.

The primary reference of Hoffarth, U.S. Patent No. 5,705,476, is relied upon *supra* as disclosing low-foaming wetting agents comprising an ethoxylated-propoxylated alcohol of formula (Ic), wherein R¹ is isodecyl (see abstract, col. 1, lines 45-col. 2, lines 46, and col. 2, line 66-col. 3, line 11). It is further taught by Hoffarth that the low-foaming wetting agents are used for treating crops, textiles and other surfaces (see abstract and col. 4, lines 10-24), per the requirements of the instant invention. Specifically, note Examples A-K. Hoffarth does not teach or suggest in general making their alkoxylates in the presence of a double-metal cyanide catalyst, as required in instant claims 18-19.

The secondary reference of Clement et al, WO 01/04183, discloses a process for preparing ethyleneoxide-propyleneoxide alcohols with metal cyanide catalysts (see abstract). It is further taught by Clement et al that double-metal cyanide catalysts enhance and make easier the polymerization of polymers that contain both blocks of propyleneoxide and ethyleneoxide (see page 2, lines 2-23).

Therefore, in view of the teachings of the secondary reference of Clement et al, one having ordinary skill in the art would be motivated to modify the primary reference of Hoffarth by using a double-metal cyanide catalyst to enhance the polymerization process. Such modification would be obvious because one would expect that the use of a double-metal cyanide catalyst, as taught by Clement et al, would be similarly useful and applicable to the analogous polymerization process taught by Hoffarth.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 11-17 and 20-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No.

6,680,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,680,412 claims a similar mixture and a process for using a composition containing an alcohol alkoxylate of formula (I) and formula (II) (see claims 1-21 of U.S. Patent No. 6,680,412), as required in the instant claims. Therefore, instant claims 11-17 and 20-30 are an obvious formulation in view of claims 1-21 of U.S. Patent No. 6,680,412.

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12. Claims 11-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/575,760. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/575,760 claims a similar mixture and a process for making and using a composition containing alkoxylates of 2-propylheptanol and alkoxylates of 2-propyl-4-methyl-hexanol (see claims 1-9 of copending Application No. 10/575,760), as required in the instant claims. Therefore, instant claims 11-30 are an obvious formulation in view of claims 1-9 of copending Application No. 10/575,760.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00AM-5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM

Brian P Mruk
February 16, 2007

Brian P. Mruk

Brian P Mruk
Primary Examiner
Art Unit 1751